

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Anthony Auffret et al.
Ser. No. : 10/601,355
Filing Date : June 23, 2003
For : PROCESS FOR CONTROLLING THE HYDRATE MIX OF
A COMPOUND
Examiner : Chung, Susannah Lee
Art Unit : 1626
Atty. Docket : PC22039A

Mail Stop: Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Petition to Adjust Patent Term Adjustment (PTA)

Indicated in Notice of Allowance

Sir:

1. This is a request for reconsideration of the patent term adjustment (PTA) of 0 days indicated in the Determination of Patent Term Adjustment Under 35 USC § 154(b) that was attached to the Notice of Allowance mailed on June 19, 2007. It is respectfully requested that a PTA of 116 days be afforded to the present application.
2. The issue fee has not yet been paid.
3. Applicants submit below in Section II a Statement of Facts as required by 37 C.F.R. § 1.705(b)(2). In summary, Applicants disagree with the Office of Petitions that there was a delay associated with Applicants' Response after Final Rejection filed on June 5, 2007. According to the PTO's calculation, 217 days of patent term was deducted between October 31, 2006, three months after the mailing date of the Final Office Action (July 31, 2006), and June 5, 2007, the

filing date of the Amendment after Final Rejection. The PTO calculation obtained from the PAIR website is attached as Exhibit A. But the period for the July 31, 2006 Final Office Action was restarted on April 12, 2007. Specifically, on April 12, 2007 a Final Office Action was issued to replace the Office Action issued July 31, 2006. Thus, the period between July 31, 2006 and June 5, 2007 should not be deducted from the patent term. Further, Applicants filed a response (June 5, 2007) to the Final Office Action (April 12, 2007) within three months of the mailing date, hence, no patent term should be deducted between April 12, 2007 and June 5, 2007 (37 CFR 1.704(b)). Accordingly, the 217 days of patent term debit calculated by the Office of Petitions and associated with Applicants' response dated June 5, 2007 should be zero..

4. The fee set forth in § 1.18(e) (\$200), as required by 37 C.F.R. § 1.705(b)(1), is paid as follows: Please charge deposit account 16-1445 in the amount of \$200.

I. Background

A. Summary of relevant Prosecution History

1. A Notice of Allowance was mailed on June 6, 2007, for the present application. One of the attachments to the Notice of Allowance was a Determination of Patent Term Adjustment Under 35 U.S.C. § 154(b) that indicated that the total PTA to date was 0 days.
2. A Final Rejection mailed July 24, 2006 was undelivered by the U.S. mail, and was returned to sender (see last page of "Mail returned to USPTO as undelivered" dated August 8, 2006 in PAIR).
3. On February 2, 2007 Applicants submitted "Proof of Non-Receipt of the Office Action and Request to Reset the Clock."

4. On April 12, 2007 an Office Action was issued to replace the Office Action issued July 31, 2006 (in essence, withdrawing the July 31, 2006 Office Action) and to restart the clock for the period of response by Applicants.
5. Applicants responded to the April 12, 2007 Office Action on June 5, 2007, within the 3 month period of reply under rule 1.704(b).

II. Statement of Facts Required by 37 C.F.R. § 1.705(b)(2)(i), (ii), (iii) and (iv)

A. 37 C.F.R. § 1.705(b)(2)(i) - Correct PTA and the Basis or Bases under § 1.702 for the Adjustment

1. The correct total PTA credit is 116 days.
2. The basis for the entire PTA credit of 116 days is under rule 1.702(a)(1) and is due to the delay of the PTO's response (i.e., December 10, 2004) to Applicants' filing date of June 23, 2003.

B. 37 C.F.R. § 1.705(b)(2)(ii) - Relevant Dates as Specified in §§ 1.703(a) - (e) for Which an Adjustment is Sought and the Adjustment as Specified in § 1.703(f) to Which the Patent Is Entitled

1. The only relevant dates as specified in rule 1.703(a)(1) for the total PTA credit is Applicants' filing date of June 23, 2003 and the PTO's first response dated December 10, 2004. This results in a patent term credit of 116 days. However, the Office of Petitions incorrectly applied a patent term debit relating to Applicants' Response dated June 5, 2007. However, since this Response was in response to the April 12, 2007 Office Action, under rule 1.704(2), there should be no patent term debit.
2. The total PTA under § 1.703(f) is 116 days, which is the total PTA credit for PTO delay of 116 days less the total PTA debit for applicant delay of 0 days.

C. 37 C.F.R. § 1.705(b)(2)(iii) - Is Patent Subject To a Terminal Disclaimer

1. The patent granted on this application is subject to a terminal disclaimer.
(Attached as Exhibit B). There is no expiration date indicated on the terminal disclaimer.

D. 37 C.F.R. § 1.705(b)(2)(iv) - Circumstances During the Prosecution of This Application Constituting a Failure to Engage in Reasonable Efforts to Conclude Processing or Examination

1. There are no circumstances during prosecution by Applicant that constitute a failure to engage in reasonable efforts to conclude processing or examination.

III. Conclusion

- A. Applicants submit that the Determination of PTA of 0 days that was attached to the Notice of Allowance mailed on June 6, 2007 is incorrect.
- B. Applicants submit that any delay associated with Applicants' Response dated June 5, 2007, should be calculated based on the Office Action mailed April 12, 2007 and pursuant to rule 1.704(b) and that a PTA of 116 days should be afforded to the present application. The PTA of 116 days results from a total PTA credit of 116 days less PTA debits of 0 days.

Respectfully submitted,

Date: September 20, 2007

/Jason G. Tebbutt/
Jason G. Tebbutt
Attorney of Record
Reg. No. 55,671

Pfizer Inc
Patent Department

150 East 42nd Street -- 5th Floor
New York, New York 10017-5612
(212) 733-4827

Encl. Exhibit A - Copy of PTA History for Application No. 10/601,355 Printed from
 PAIR on September 20, 2007; and
 Exhibit B - Copy of Terminal Disclaimer.

10/601,355

PROCESS FOR CONTROLLING THE HYDRATE MIX OF A COMPOUND

09-20-
2007::15:42:10**Patent Term Adjustments**

Patent Term Adjustment (PTA) for Application Number: 10/601,355

Filing or 371(c) Date:	06-23-2003	USPTO Delay (PTO) Delay (days):	116
Issue Date of Patent:	-	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	217
Post-Issue Petitions (days):	+0	Total PTA (days):	0
USPTO Adjustment(days):	+0	Explanation Of Calculations	

Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
06-20-2007	Mail Notice of Allowance		
06-18-2007	Notice of Allowance Data Verification Completed		
06-18-2007	Case Docketed to Examiner in GAU		
06-18-2007	Document Verification		
06-13-2007	Paralegal TD Accepted		
06-05-2007	terminal disclaimer fee paid		
06-05-2007	Terminal Disclaimer Filed		
06-11-2007	Date Forwarded to Examiner		
06-05-2007	Amendment after Final Rejection		217
04-12-2007	Mail Notice of Restarted Response Period		⌘
04-10-2007	Letter Restarting Period for Response (i.e. Letter re: References)		⌘
02-01-2007	Miscellaneous Incoming Letter		⌘
07-31-2006	Mail Final Rejection (PTOL - 326)		⌘
07-24-2006	Final Rejection		
06-13-2006	Date Forwarded to Examiner		
06-12-2006	Response after Non-Final Action		
03-13-2006	Mail Non-Final Rejection		
03-09-2006	Non-Final Rejection		
02-08-2006	Date Forwarded to Examiner		
01-20-2006	Response to Election / Restriction Filed		
01-20-2006	Request for Extension of Time - Granted		
11-23-2005	Mail Restriction Requirement		
11-22-2005	Requirement for Restriction / Election		
11-03-2005	Case Docketed to Examiner in GAU		
09-13-2005	Date Forwarded to Examiner		
09-13-2005	Date Forwarded to Examiner		
09-02-2005	Request for Continued Examination (RCE)		
09-13-2005	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)		
09-02-2005	Workflow - Request for RCE - Begin		
08-31-2005	Case Docketed to Examiner in GAU		

06-02-2005	Mail Final Rejection (PTOL - 326)	
05-31-2005	Final Rejection	
03-24-2005	Date Forwarded to Examiner	
03-11-2005	Response after Non-Final Action	
12-17-2004	Mail Non-Final Rejection	116
12-10-2004	Non-Final Rejection	✖
01-16-2004	IFW TSS Processing by Tech Center Complete	✖
01-16-2004	Case Docketed to Examiner in GAU	✖
09-02-2003	Information Disclosure Statement (IDS) Filed	✖
09-02-2003	Information Disclosure Statement (IDS) Filed	✖
09-02-2003	Application Return from OIPE	✖
09-02-2003	Application Return TO OIPE	✖
09-02-2003	Application Return from OIPE	✖
09-03-2003	Application Is Now Complete	✖
09-02-2003	Pre-Exam Office Action Withdrawn	✖
09-02-2003	Application Return TO OIPE	✖
08-28-2003	Application Dispatched from OIPE	✖
08-29-2003	Application Is Now Complete	✖
08-12-2003	Cleared by OIPE CSR	✖
07-15-2003	IFW Scan & PACR Auto Security Review	✖
06-23-2003	Initial Exam Team nn	✖

[Close Window](#)

PC22039A
Terminal Disclaimer For Appln. No. **10/601,355**

Certificate of Transmission (37 C.F.R. §1.8);
I hereby certify that this correspondence is being
electronically transmitted via **EFS-Web** to the United
States Patent and Trademark Office, **Commissioner For
Patents**, on this **5th** day of **June** 2007.

s/ /Donna Di Maccio/
Donna Di Maccio

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:
Anthony David Auffret, et al.

Group Art Unit: 1751

Serial No.: 10/601,355

Examiner: Susannah Chung

Confirmation No: 7465

Filed: June 23, 2003

**For: PROCESS FOR CONTROLLING THE
HYDRATE MIX OF A COMPOUND**

TERMINAL DISCLAIMER

Madam:

Pfizer Inc., owner of all title and interest in the above-identified application by virtue of an Assignment recorded at Reel 013334, Frame 0282, hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on this application that would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §§ 154-156 and 173 as shortened by any terminal disclaimer filed before the grant of U.S. Patent No. 6,977,302 issued on prior U.S. Patent Application Serial No. 10/810,100, filed on March 26, 2004. The owner agrees that any patent granted on the present application shall be enforceable only for and during such period that it and U.S. Patent No. 6,977,302 are commonly owned. A copy of the Notice of Recordation for the patent family of US Patent No. 6,977,302, having Reel/Frame No. of 9828/0484 is attached. This agreement runs with any patent granted on the present application and is binding on the grantee and its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the present application that would extend to the expiration date of the full statutory term as term defined in 35 U.S.C. §§ 154-156 and 173 of the patent, as presently

shortened by any terminal disclaimer, in the event that such granted patent: expires for failure to pay a maintenance fee; is held unenforceable; is found invalid by a court of competent jurisdiction; is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321; has all claims canceled by a reexamination certificate; is reissued; or is in any manner terminated before the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

Please charge any fees not submitted herewith required for filing this terminal disclaimer, including the fee under 37 C.F.R. § 1.20(d), to Deposit Account No. 16-1445.

This is a submission on behalf of the owner. The undersigned is empowered to act on behalf of the owner.

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true. I further declare that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of this application or any patent issuing thereon.

Respectfully submitted,

Date: June 5, 2007

/Elsa Djuardi/
Elsa Djuardi, Ph.D.
Attorney For Applicants
Registration No. 45,963

Pfizer Inc
Patent Dept.
10555 Science Center Drive
San Diego, California 92121
Phone: (858) 638-6117
Fax: (858) 678-8233